

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all pending claims 1-6. Applicants have amended claim 1 to incorporate the subject matter of claim 3.

Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song (US 6,192,547) in view of Hasumi et al. (US 5,351,354). These rejections are rendered moot by the incorporation of the subject matter of claim 3 into independent claim 1.

Turning, therefore, to the rejection of claim 3 (now claim 1), the Office Action rejected claim 3 as allegedly obvious over the combination of Song in view of Hasumi in further view of Reinwald (U.S. 4,161,430) and Young (U.S. 5,265,298).

Amended claim 1 recites an automatic air-blown cleaning apparatus comprising a conveying device and an air filtering blower provided on the conveying device. The air filtering blower **sends an air flow in a conveyed direction of the conveying device.**

Song discloses an air curtain system 1 including a front slanted portion 10 and a slit 15, wherein the air passes through the slit 15. However, referring to every figure in Song, the slit 15 is shown opened toward the opposite direction of a conveyed direction. That is, **the air curtain system 1 does not blow air in a conveyed direction.**

Hasumi discloses a conventional dust cleaner including a blower 2, and a Punkah louver 4. Especially shown in Figs. 3 and 4, **Punkah louver 4 does not blow air in a conveyed direction.**

To combine Song with Hasumi, it is still **not taught that the air filtering blower sends an air flow in a conveyed direction of the conveying device.** Furthermore, this claimed feature is not properly taught by either Reinwald or Young.

Further, and as a separate and independent basis for the patentability of all claims, Applicants respectfully submit that the Office Action has failed to cite a proper suggestion or motivation for combining the selected features from the four cited references. In combining these references, the Office Action failed to identify a proper motivation or suggestion for making the combination. In this regard, the Office Action stated only that it would have been obvious to combine Hasumi with Song "for the purpose of filtering the air to remove dust particles from the air and to increase the air speed." (Office Action, p. 3). The Office Action then alleged that the further combination of Reinwald would have been obvious "for the purpose to enhance the filter strength." (Office Action, p. 4). Finally, the Office Office Action alleged that the further combination of Young would have been obvious "for the purpose to remove dust particles before entering into the blower, which would contaminate the blower." (Office Action, p. 5) These alleged rationales are clearly improper or insufficient in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an automatic air-blown cleaning apparatus as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *See In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998);

Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000).

Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir.1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed.Cir.1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.' " *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed.Cir.1992) (quoting *Lindemann*, 730 F.2d at 1462, 221 USPQ at 488).

The alleged rationales (set forth above) are clearly improper (as a motivation for combination), in view of the above-discussed Federal Circuit precedent.

For at least these reasons, all pending claims 1-2 and 4-6 patently define over the cited art and the rejections should be withdrawn.

No fee is believed to be due in connection with this amendment and response. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted,

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